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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,559	01/21/2004	Hassan S. Niknafs	FLCZ 2 00383 (H-4357)	2859
58134	7590	05/09/2006	EXAMINER	
SAINT-GOBAIN CORPORATION			XU, LING X	
P.O. BOX 15008			ART UNIT	
ONE NEW BOND STREET, INTELLECTUAL PROPERTY DEPART.			PAPER NUMBER	
WORCESTER, MA 01615-0008			1775	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/761,559

Applicant(s)

NIKNAFS ET AL.

Examiner

Ling X. Xu

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I claims 1-14 and 16-17 in the reply filed on 4/13/2006 is acknowledged.

Claims 18-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 4/13/2006.

The requirement is still deemed proper and is therefore made FINAL.

### *Terminal Disclaimer*

2. The two terminal disclaimers filed on 4/13/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent Nos. 6,889,963 and 6,699,562 have been reviewed and are accepted. The terminal disclaimers have been recorded.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 and 16-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

Art Unit: 1775

was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-14 and 16-17 have been amended to recite “a bed of randomly oriented ceramic packing.” However, the specification does not recite that the ceramic packing element is randomly oriented. Applicant indicated that the support for the amendment can be found in paragraph 23 and 32. In paragraph 23, there is no description about the randomly oriented ceramic packing. In paragraph 32, it states that “the elements 10 can be packed into a tower or column to form a bed of packing elements. The column may be horizontally or vertically orientated.” This indicates that the packing is not randomly oriented but horizontally or vertically orientated.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9 and 16-17 stand rejected under 35 U.S.C. 102(b) as being anticipated by Chernyshev et al. (Wo-99/29425) for the reasons of record set forth in the prior Office action dated on 10/13/2005.

5. Claims 1-8, 10-14 and 16-17 stand rejected under 35 U.S.C. 102(e) as being anticipated by Morita et al. (US 2003/0170160) for the reasons of record set forth in the prior Office action dated on 10/13/2005.

***Claim Rejections - 35 USC § 103***

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morita as applied to claim 1 above, and further in view of the same reference for the reasons of record set forth in the prior Office action dated on 10/13/2005.

***Response to Arguments***

7. Applicant's arguments filed 4/13/2006 have been fully considered but they are not persuasive.

Applicant argues that neither of the cited references describes ceramic media for use in heat transfer or mass transfer processes and asserts that the cited references are directed to a different technical field.

Applicant's arguments are not commensurate in scope with the claims. Because the claims do not require the argued limitations that the ceramic media for use in heat transfer or mass transfer processes.

In addition, the rejections based on the cited references made in the prior Office action are under 35 USC 102. "Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). >See also *State Contracting & Eng ' g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir.2003) (The question of whether a reference is

Art Unit: 1775

analogous art is not relevant to whether that reference anticipates. A reference may be directed to an entirely different problem than the one addressed by the inventor, or may be from an entirely different field of endeavor than that of the claimed invention, yet the reference is still anticipatory if it explicitly or inherently discloses every limitation recited in the claims.), *see* MPEP 2131.05[R-2].

Applicant also argues that claim 1 has been amended to distinguish over the teachings in both Chernyshev and Morita. Morita teaches monolithically molded type porous honeycomb support which are carefully oriented and stacked in a column or tower rather than dumped in the tower. The monolithic supports disclosed by Morita are not randomly oriented as amended in claim 1. Chernyshev describes prism like elements that are not randomly oriented structure as described by amended claim 1.

First, as stated above, the specification does not recite that the ceramic packing element is randomly oriented. As stated in paragraph 32 of the specification, the packing elements are not randomly oriented but horizontally or vertically orientated.

Secondly, the newly amended claims are considered to be product-by-process claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps (MPEP 2113). “[E]ven though product – by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the

Art Unit: 1775

claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966.

As stated in the prior Office action, Chernyshev and Morita disclose the ceramic packing elements having the same structure as claimed. The cited references anticipate the claimed invention even though the ceramic packing elements may be packed by a different process, such as carefully oriented and stacked instead of randomly oriented as claimed by the applicant.

### *Conclusion*

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling X. Xu whose telephone number is 571-272-1546. The examiner can normally be reached on 8:00 - 4:30 Monday - Friday.

Art Unit: 1775

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer C. McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ling X. Xu  
Primary Examiner  
Art Unit 1775